

## REMARKS/ARGUMENTS

In the Office Action, the Examiner rejected Claims 1-15. Applicants amend Claims 1 and 9 in a fashion believed to address the Examiner's rejection of claims.

### Rejection of Claims 1-15 Under 35 U.S.C. §112, Second Paragraph

The Examiner rejects the above-referenced claims due to language that allegedly makes the claims indefinite. The Examiner also rejects Claim 9 for lack of an antecedent basis. Claim 1 has now been amended to address the Examiner's concerns and Claim 9 has now been made dependent upon Claim 8, thus addressing the antecedent basis issue. As such, Applicants respectfully submit that the §112 issues have been overcome and therefore request the Examiner's favorable consideration thereof.

### Rejection of Claims 1-4, 8-9 and 10-11 Under 35 U.S.C. §102(b) as Being Anticipated by Zupon

Applicants respectfully traverse the Examiner's rejection of claims. At best, Zupon shows a reflective insulating system with fiber glass, a reflection layer of aluminum and a vapor retarding layer. The aluminum layer may be formed as a perforated layer. It is disclosed that the reflection layer reflects heat. However, Zupon does not disclose an electromagnetic-field-shielding layer, nor such a shielding layer with a mesh size of 5 mm. The size of any perforation in Zupon is not disclosed.

Zupon is not concerned with shielding electromagnetic fields emitted by mobile telephone networks. Nor does Zupon disclose a material changing its diffusion resistance as a function of ambient moisture, because polypropylene has the same retarding coefficient for all values of ambient moisture.

Applicants submit that anticipation requires disclosure of each and every claim limitation in a single prior art reference, either explicitly or inherently. *In re Omeprazole Patent Litigation*, 483 F.3d 1364, 1371 (Fed. Cir. 2007). In the present case, Zupon fails to disclose recited elements of Claim 1, including at least one electromagnetic field-shielding layer for shielding electromagnetic fields in the frequency range of mobile telephone networks, such layer in the form of an electrically conducting film or a magnetic-shielding film and which further comprises a laminated electrically conducting non-woven bonded metal lattice or a vapor deposited layer of electrically conducting substances, each having a mesh size of 5 mm. In view of these

differences between the claimed invention and Zupon, Applicants respectfully request that the Examiner reconsider and withdraw all §102 rejections of the above-referenced claims.

Rejection of Claims 1-4 Under 35 U.S.C. §102(b) as Being Anticipated by Brinton

Brinton shows garments for clean rooms with a vapor retarding layer having an inner layer of conducting fibers, coated with carbon or a metal. Brinton neither shows a vapor retarding material changing its diffusion resistance as a function of ambient moisture nor a shielding layer with a mesh size of 5 mm. Applicants incorporate the legal authority cited above and contend that in view thereof, Brinton simply does not anticipate the above-referenced claims. Each and every element of the claimed invention at issue here is neither disclosed nor inherently taught by Brinton. As such, Applicants respectfully request the Examiner to reconsider and withdraw the §102(b) rejections of such claims.

Rejection of Claims 1-15 Under 35 U.S.C. §102(b) as Being Anticipated by, or in the Alternative, Under §103(a), as Obvious Over Jensen

Applicants incorporate by reference the factual and legal arguments set forth above and contend that just like Zupon and Brinton, Jensen fails to anticipate the present claims.

Jensen discloses a vapor barrier for an underroof for buildings, the underroof having a vapor diffusion resistance that varies in dependency of the relative humidity. (See [0007] of Jensen).

In contrast to Jensen, embodiments of the present invention are directed to a vapor retarder capable of shielding electromagnetic fields emitted by mobile telephone networks. This is achieved by the subject matter of claim 1, namely that “the vapor retarder has at least one electromagnetic-shielding-fielding layer for shielding electromagnetic fields in the frequency range of mobile telephone networks, which is formed so as to be permeable to diffusion and which is in the form of an electrically conducting film and/or in the form of a magnetic-shielding film, or comprises a laminated, electrically conducting nonwoven, an especially bonded metal lattice or a vapor-deposited layer of electrically conducting substances, each having a mesh size of 5 mm”.

Jensen neither discloses a vapor retarder with at least one electromagnetic-field-shielding layer for shielding electromagnetic fields in the frequency range of mobile telephone networks

nor such a shielding layer with a mesh size of 5 mm. Jensen only discloses mesh sizes of less than 1.5 mm (see [0032]).

Jensen does not teach or suggest the features of the present claims. Jensen neither addresses the problems addressed by the present invention, nor does Jensen teach electromagnetic shielding layers with mesh sizes of 5 mm. Although in Fig. 3 and Fig. 4 of Jensen an underroof laminate which comprises an outer layer 29 which is in the form of a perforated plastic film or metal foil is disclosed, Jensen fails to disclose an electromagnetic-field-shielding layer for shielding electromagnetic fields in the frequency range of mobile telephone networks. Furthermore, the plastic film or metal foil of Jensen is not specified as being able to act as electromagnetic shielding for electromagnetic fields in the frequency range of mobile telephone networks and those skilled in the art would not obtain this information by simply reading Jensen because the plastic film and/or metal foil of Jensen is perforated and no parameters for its thickness are given.

Jensen, in combination with other state of the art documents, would lead those skilled in the art away from the present invention and would teach away from the present invention.

WO 03/047850 A1 teaches non-perforated metal films for electromagnetic shielding. In more detail, the metal layers mentioned in WO 03/047850 A1 are characterized as electromagnetic shielding for high and low frequencies (see page 9, second paragraph “Abschirmung ... gegen elektromagnetische hoch- und niederfrequente Wechselfelder”), which is facilitated by a layer thickness of 10 to 10.000 µm together with a solid, i.e. non-perforated structure (see page 11, fifth paragraph). Therefore, in view of a combination of Jensen and WO 03/047850 A1 those skilled in the art would use the non-perforated foil of WO 03/047850 A1 for shielding high and low frequency electromagnetic fields, i.e. fields of mobile telephone networks.

Based on the teachings at the time of the present invention, those of skill in the art would, at best, employ a metal wire cloth with a mesh size of less than 1 mm (see column 3, lines 16 to 19 and column 4, lines 46 to 50). Muth teaches that this mesh size is needed for shielding electromagnetic waves, in a frequency range of 3 kHz to 40 GHz, i.e. the range of mobile telephone networks.

It is well established that in determining the scope and content of the prior art, and determining whether the prior art suggested the claimed invention, the references “must be read

as a whole and consideration must be given where the references diverge and teach away from the claimed invention". *Akzo N.V. v. United States Int'l Trade Commission*, 1 USPQ2d 1241 (Fed. Cir. 1986) cert denied, U.S. 909 (1987); *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593 (Fed. Cir), cert denied, 481 U.S. 1052 (1987). The Examiner cannot fairly isolate certain features of the prior art without consideration of how the other disclosed features may affect the claimed device as a whole, as well as how one of ordinary skill in the art would be affected by such structural elements, especially as to how one reference may be combined with another. The alleged teachings of a reference cannot be viewed in the abstract. Rather, they must be considered in the context of the teaching of the entire reference. *See Dembiczak*, 175 F.3d at 999. Care must be taken to avoid hindsight reconstruction while using the patent in suit as a guide through the maze of prior art references, combining just the right references in just the right way so as to achieve the result of the claims in suit. *Grain Processing Corp. v. American Maize Products Company*, 840 F.2d 902, 907, 5 USPQ 2d. 1788, 1792 (Fed. Cir. 1988). One cannot pick and choose individual elements from multiple references to recreate the invention. *Polaroid Corp. v. Eastman Kodak Co.*, 229 USPQ 561 (Fed. Cir.), cert. denied, 479 U.S. 850 (1996). "Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

Surprisingly, the inventors of the present patent application established that for the best shielding of electromagnetic waves in a frequency range of mobile telephone networks, a mesh size of 5 mm is needed. This mesh size is neither disclosed nor obviously suggested by the prior art.

The Federal Circuit in *Andersen Corporation v. Pella Corporation*, (Fed. Cir. 2007-1536 Nov. 19, 2008) reversed the district court due to an incorrect, overly stringent application of the *KSR* decision. Specifically, the Court focused on how the prior art would have been considered by one of ordinary skill in the art and whether it would have discouraged one from incorporating certain elements into a device. The Federal Circuit held that it must still consider evidence of teachings not to combine certain teachings because, according to the Supreme Court, they "capture[ ] a helpful insight" into the obviousness inquiry. 127 S. Ct. at 1741. The Federal Circuit, citing the *KSR* decision, found that with evidence of a "teaching away" from the combination of prior art references a conclusion of obviousness could not be made. The Supreme

Court in *KSR* approvingly cited *United States v. Adams*, 383 U.S. 39, 51-52 (1966), for the "principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." 127 S. Ct. at 1739-40. See *Para-Ordnance Mfg., Inc. v. SGS Imps. Int'l, Inc.*, 73 F.3d 1085, 1088 (Fed. Cir. 2005) ("[W]hether [the prior art] teaches toward or away from the claimed invention also is a determination of fact."). The Federal Circuit reversed the district court, which attempted to rely on *KSR* for the proposition that "common sense might make alternative uses of familiar items obvious and that design incentives and other market forces can prompt variations of a work." *See id.* (citing *KSR*, 127 S. Ct. at 1740, 1742). In *Andersen*, the Federal Circuit found that the district court was wrong to conclude that common sense and the nature of the problem to be solved would have made it obvious to use a particular shielding mesh as an insect screen. *Id.* Similarly, here, the use of a mesh size of 5 mm would not have been obvious to one of skill in the art at the time of the present invention and the prior art teaches away from the claimed invention. For this reason alone, the Examiner should withdraw the rejection of claims and pass the claims to allowance.

Applicants further provide WO 03/047850 A1 and US 6,512,173 B1 from parallel European patent proceedings. The claimed invention is patentable over any one or combination of such references.

WO 03/047850 A1 shows a multilayer water vapor-impermeable film for buildings with one metal layer (see abstract) for electromagnetic field shielding (see page 9, second paragraph).

Muth shows an insulation plate with perforated aluminum film for protection against detrimental electromagnetic fields (see abstract). The insulation plate does not have any vapor retarding layer.

Based upon the foregoing, Applicants believe that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

SHERIDAN ROSS P.C.

By:

Joseph E. Kovarik  
Registration No. 33,005  
1560 Broadway, Suite 1200  
Denver, Colorado 80202-5141  
(303) 863-9700

Date: 3/12/09

J:\2584\SG-7\AMENDMENT AND RESPONSE.doc